

### **REMARKS/ARGUMENTS**

In the specification, the paragraphs [0012], [0025], [0048], [0054], [0083], [0084], [0101], [0126], [0130], [0133], [0138], [0189], [0194], [0198], and [0199] have been amended to correct minor editorial matters.

Claims 1-24 are pending in this application. Claim 1 has been amended, and claims 23 and 24 have been added. Claims 1, 2, and 21-23 are independent claims. Applicant kindly requests favorable reconsideration of the application in view of the present amendments and the following discussion.

#### **Claim 1**

The Examiner has asked the Applicant to show that claim 1 is patentable in view of Finch. M.P.E.P. § 2131 states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Finch fails to describe every step set forth in claim 1 and thus fails to anticipate claim 1.

Claim 1 recites the step of "identifying the requestor as either human or a search engine spider by examining a user-agent tag and an IP address of an HTTP request of the requestor, and comparing the user-agent tag and the IP address with requesting agent characteristics stored in a signature database," which Finch fails to disclose. Finch is silent on "examining a user-agent tag and an IP address" of the requestor. Finch is also silent on comparing this examination with a signature database storing requestor characteristics to identify a requestor of web content. Because Finch does not teach every element of claim 1 as required by M.P.E.P. § 231, Finch does not anticipate claim 1. Claim 1 is therefore patentable over Finch.

#### **Claim 7**

The Examiner has asked the Applicant to show that claim 7 is patentable over Finch in view of Chiu. As required, by M.P.E.P § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure.

Finch and Chiu combined do not teach or suggest all of the claim limitations of claim 7. Additionally, there is no motivation to modify or combine Chiu with Finch. Thus Finch combined with Chiu does not establish a *prima facie* case of obviousness for claim 7. Claim 7 is therefore patentable over Finch in view of Chiu.

Claim 7 is dependent on claim 1 and incorporates all of the limitations of claim 1. Thus claim 7 recites the step of "examining a user-agent tag and an IP address" of a requestor, and using a "signature database" to identify the requestor. As discussed above, Finch fails to disclose this step. Chiu, also, does not disclose or suggest this step. Chiu discloses receiving a request for web page information, but Chiu is silent on the examination of user-agent tags, and silent on using signature databases. Further, Chiu is silent on identifying requestors of web page content. Because Finch and Chiu combined do not teach or suggest all the claim limitations of claim 7, the third requirement of the *prima facie* case of obviousness, as required by M.P.E.P. § 2143, has not been met.

Additionally, there is no suggestion or motivation to combine Finch with Chiu because Chiu does not address the nature of the problem to be solved. Chiu does not relate to solutions for identifying and redirecting requestors of web content. Instead, Chiu relates to editing or "post processing" hypertext documents, i.e., adding information to documents after the documents are posted on the World Wide Web, Chiu col. 2, lines 48-64. Furthermore, Chiu does not disclose search engine spiders. With no treatment of search engine spiders, a person of ordinary skill in the art has no motivation to combine Chiu with Finch to address identifying search engine spiders. Because of the lack of motivation to combine Finch with Chiu, Finch and Chiu do not meet the first requirement of the *prima facie* case of obviousness. Thus Finch in view of Chiu fails to meet two of the three requirements of the *prima facie* case of obviousness as required by M.P.E.P. § 2143. Claim 7 is therefore patentable over Finch in view of Chiu.

## Claims 8-10

The Examiner has asked the Applicant to show that claims 8-10 are patentable over Finch in view of Chiu and further in view of Williams. As required, by M.P.E.P § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure.

Finch, Chiu, and Williams combined do not teach or suggest all of the claim limitations of claims 8-10. Additionally, there is no motivation to modify or combine Finch, Chiu, and Williams. Thus Finch combined with Chiu and Williams does not establish a *prima facie* case of obviousness for claims 8-10. Claims 8-10 are therefore patentable over Finch in view of Chiu.

Claims 8-10 depend on claim 7, which depends on claim 1, and incorporate all the limitations of claims 7 and 1. Thus claims 8-10 recite the step of examining a user-agent tag and an IP address of a requestor, and using a signature database to identify the requestor. As discussed above Finch and Chiu combined fail to disclose this step. Williams, combined with Finch and Chiu, also fails to disclose this step. Williams discloses a car rental reservation system for making reservations over the Web (page 1, paragraph 0015; page 2 paragraph 0035). Williams is silent on examining a user-agent tag and an IP address of a requestor, and on comparing the examination with a signature database. Thus Williams combined with Chiu and Finch does not disclose all of the claim limitations of claims 8-10.

Williams is also silent on search engine spiders. With no treatment of search engine spiders, there is no motivation to combine Williams with Chiu and Finch. With no motivation to combine these references, and by the combination of these references failing to teach or suggest all the claim limitations, these references do not meet two of the three requirements for a *prima facie* case of obviousness as required by M.P.E.P § 2143. Claims 8-10 are therefore patentable over Finch in view of Chiu and further in view of Williams.

## **Claims 2-6, 11-22**

The Examiner has asked the Applicant to show that claims 2-6 and 11-22 are patentable over Finch in view of Yacoby. Claims 2-6 and 11-22 are patentable over Finch and Yacoby, because (1) Finch and Yacoby combined fail to teach all of the claim limitations and (2) because there is no motivation to combine Yacoby with Finch as required by M.P.E.P § 2143.

Claim 2 is an independent claim. Claim 2 recites the step of "dynamically generating one or more web pages optimized for identified search engine spiders," which both Finch and Yacoby Fail to disclose. As stated in the Office Action, Finch does not disclose this step. Yacoby is also silent on teaching dynamically generating optimized search engine content pages. This is evident from Yacoby's response to search engine spiders.

In Yacoby, col. 7, lines 16-19, Yacoby discusses detecting search engine spiders and denying access to search engine spiders. Yacoby describes a search engine spider as software that creates "user interactions that are automatically generated" (col. 7, lines 16-19). In col. 10, lines 45-50, Yacoby explicitly defines a search engine spider as "a software program that generates automatic queries to retrieve information." These "automatically generated" user interactions are simply automatically generated *requests* for web page information. A human manually enters a web page request, but since a spider is a computer program, a spider automatically generates its requests for web pages.

A human interacting with a web site is generally limited on the number of requests she sends and the duration of a visit. A search engine spider, however, can automatically send numerous requests for web page content with minimal time between requests. Yacoby detects search engine spiders based on the number of requests sent by a requestor and the duration of the requests. If Yacoby detects a spider, Yacoby blocks the spider and sends a warning (col. 10, lines 48-52). This is the extent of Yacoby's treatment of a search engine spider. To dynamically generate an optimized web page for an identified search engine spider upon a spider request, the spider must at least have access to the web page. With the spider request blocked, Yacoby logically does not teach or suggest dynamically generating optimized web pages for identified search engine spiders.

Since Yacoby blocks a search engine spider upon detection and ceases to communicate with the spider, Yacoby and Finch combined do not teach or suggest dynamically generating optimized web pages for identified search engine spiders.

Yacoby teaches away from assisting search engines. The principle of operation of Yacoby is blocking search engine spiders to help humans. Yacoby even teaches "search engines are cumbersome to use" (col. 2, lines 3-6). Yacoby, instead, relates to a directory to find a person's web page using a telephone number. Because Yacoby teaches away from giving access to search engine spiders, there is no motivation to combine Finch and Yacoby. M.P.E.P. § 2143.01 states that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." Considering that the principle of operation of Yacoby is to *hinder* spiders, combining Yacoby with Finch to teach a claim limitation for *helping* spiders would change the principle of operation of Yacoby. Therefore there is no suggestion or motivation to combine Finch and Yacoby.

With no motivation to combine these references, and by the combination of these references failing to teach or suggest all the claim limitations, Finch and Yacoby combined do not meet two of the three requirements for a *prima facie* case of obviousness as required by M.P.E.P. § 2143. Claim 2 is therefore patentable over Finch in view of Yacoby.

Claims 3-6 and 11-20 depend from independent claim 2 and incorporate all the limitations of claim 2. M.P.E.P. § 2143.03 states: "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." As discussed above, claim 2 is nonobvious under 35 U.S.C. 103. Because claims 3-6 and 11-20 depend on nonobvious claim 2, claims 3-6 and 11-20 are also nonobvious. Claims 3-6 and 11-20 are therefore patentable over Finch in view of Yacoby.

Claims 21 and 22 are independent claims that both include the step from claim 2 of "dynamically generating one or more web pages optimized for identified search engine spiders." As discussed above, Finch and Yacoby failed to establish a *prima facie* case of obviousness in that they failed to teach or suggest this step, and there was no motivation to combine the references to teach this step. Claims 21 and 22 are therefore patentable over Finch in view of Yacoby.

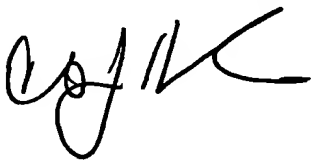
### **Claim 23-24**

New claims 23 and 24 contain subject matter from claim 2 and thus new claims 23 and 24 are believed to be allowable. For example, claims 23 and 24 contain the step of "dynamically generating one or more web pages for the named search engine spider by merging content data from the content database with the template to produce one or more web pages." This limitation is the dynamically generated optimized web page for an identified search engine spider from claim 2. Therefore new claims 23 and 24 are patentable over the cited references.

### **Summary**

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,



Erik J. Heels  
Registration No. 39,218  
Customer No. 30,948

Date: 07-15-2004

Clock Tower Law Group  
2 Clock Tower Place, Suite 255  
Maynard, MA 01754  
Phone: 978-823-0008  
E-mail: uspto@clocktowerlaw.com